

### **REMARKS**

Claims 1-16 are pending in the Application and stand rejected. In response to the Office Action, Applicants have traversed the rejection; no claims have been amended, added, or cancelled. For the reasons provided herein, the Application is believed to be in condition for allowance, which action is respectfully requested.

#### **Claim Rejections – 35 USC § 103**

In paragraph 3 of the Office Action, the Examiner rejected claims 1-16 under 35 USC 103(a) as being unpatentable over *Vialen et al.* (U.S. Patent No. 6,898,429) in view of *Sharma* (U.S. Pat. App. No. 2005/0009527). In response, Applicants respectfully traverse, for the reasons set forth below.

Applicants again point out that *Sharma* was published on 13 Jan 2005, and filed on 28 Jun 2004. The present Application was filed on 29 Sep 2003, meaning that *Sharma* cannot be cited as prior art against it. In the Office Action, the rejections of each of the independent claims 1 and 9 require the application of *Sharma* (in combination with *Vialen*), and are therefore improper. Since the dependent claims 2-8 and 10-16 also include all of the limitations of claims 1 and 9, the rejections of these claims necessarily require use of *Sharma* and must fail for the same reasons.

Applicants acknowledge that *Sharma* claims priority to U.S. provisional application No. 60/486,584 (“Provisional”) filed 11 Jul 2003 (*Sharma* at paragraph 0001]). The Provisional, however, is not cited in the Office Action, and apparently is not being used as a reference for the rejections of the present Application’s claims. Nor is there any statement in the Office Action that the Provisional has any effect on the patentability of the claims.

It is clear, however, that the respective disclosures of *Sharma* and the Provisional are markedly different, meaning that the filing date of the Provisional cannot simply be ascribed to the disclosure of *Sharma*. And to the extent that the portions of *Sharma* cited in the Office Action are believed for some reason to deserve effectiveness as of the Provisional filing date, this is nowhere stated. In fact, the citation to *Sharma* in the Office Action rather than to the

Provisional itself would appear to be an acknowledgement that sufficient disclosure is not present in the Provisional.

Applicants respectfully suggest that Sharma would be unable to assert Applicants' claims, and to overcome a (hypothetical) rejection based on the present Application merely by claiming the benefit of the Provisional filing date. Of course, Sharma would not be allowed to use the later-filed *Sharma* disclosure to support such an assertion. By the same token, the later-filed *Sharma* disclosure should not be used in combination with the Provisional to reject the claims of the present Application. Applicants admit that the Office Action does not explicitly base the rejections on any such combination, but it is not entirely clear why the later-filed *Sharma* disclosure is being cited at all.

Specifically, the Office Action cites *Sharma* at paragraphs [0071] to [0073] and [0099] to [0101] – but these six paragraphs are not to be found in the Provisional, either verbatim or in some recognizable form. Although *Sharma* Figures 3 and 4 are the same in the Provisional, and Figure 5 is similar, none of these Figures disclose the features of Applicants' claims 1 and 9 that the Office Action acknowledges are missing in *Vialen*. The relevance of these Provisional Figures to the present invention cannot even be understood without reference to *Sharma* itself. In the Provisional, Figures 3-5 are discussed, respectively, at Provisional at page 4, line 12 to page 5, line 18 and at page 7, lines 6-17. These portions of the Provisional are presumably not cited in the Office Action because they do not teach or suggest any portion of the presently-claimed invention (which they do not, they simply address problems associated with existing procedures).

Moreover it is not clear where paragraphs [0071] to [0073] and [0091] to [0099] to [0101], even if they applied, disclose a further step to be carried out in the UE if a received CUC message does not include a new value for the cell identifier and the CUC message would cause the UE mobile telecommunications device to enter a state which requires the UE mobile telecommunications device to respond to the message before entering the state. In other words, even if the *Sharma* disclosure were dated earlier, each and every limitation of the present invention is not taught or suggested in the combination of *Vialen* and *Sharma*.

In summary, as acknowledged in the Office Action, *Vialen* alone does not teach or suggest all of the limitations of either of independent claims 1 or 9. Regardless of whether it would have been obvious to combine the teachings of *Vialen* and *Sharma*, the fact that *Sharma* was not filed until 28 Jun 2004 means that it is not prior art as to the present Application. Although *Sharma* claims the benefit of the Provisional's filing date, it includes material not found in the Provisional, and it is this new matter that is cited in the Office Action. The Provisional itself is not cited in the Office Action and, even if it were, it's relatively brief disclosure would be difficult to combine with *Vialen* in any meaningful way, relative to the invention as presently claimed.

Accordingly, reexamination and reconsideration of the claims, and consideration for their allowance, is respectfully requested. Such early action is earnestly solicited.

Respectfully submitted,

/Robert H. Kelly/

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Robert H. Kelly  
Registration No. 33,922

SCHEEF & STONE, L.L.P.  
5956 Sherry Lane, Suite 1400  
Dallas, Texas 75225  
Telephone: (214) 706-4201  
Fax: (214) 706-4242  
[robert.kelly@scheefandstone.com](mailto:robert.kelly@scheefandstone.com)